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**SEP 22 2004**

**OFFICE OF PETITIONS**

In re Application of  
Chiang, et al.  
Application No. 10/635,240  
Filed: August 5, 2003  
Attorney Docket No. M0925.70138US00

:  
: DECISION ON PETITIONS  
: UNDER 37 CFR 1.78(a)(3) AND  
: UNDER 37 CFR 1.78(a)(6)  
:

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and the constructive petition under 1.78(a)(6), filed December 18, 2003 (certificate of mailing date December 16, 2003), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition fails to comply with item (1) above.

A reference to add the prior-filed applications on page one following the first sentence of the specification has been included in an amendment filed on December 18, 2003 (certificate of mailing date December 16, 2003). However, the amendment is not acceptable as drafted since it improperly incorporates by reference one of the prior-filed applications. Application no. 60/222,278 was properly incorporated by reference in the instant application on August 5, 2003, which is the application's filing date. However, petitioners seek to incorporate by reference application no. 60/221,278 (emphasis added) in the December 18, 2003 (certificate of mailing date December 16, 2003) amendment.

Petitioners' attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See In re deSeversky*, *supra*. Note also MPEP 201.06(c). Application No. 60/221,278 was **not** incorporated by reference in the present application upon the present application's filing.

Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) and a substitute amendment<sup>1</sup> deleting the improper incorporation by reference statement is required.

Regarding finances, petitioners submitted a check for \$1,300.00 with the instant petition. The petition fee for filing a petition to accept an unintentionally delayed benefit claim is \$1,330.00. Accordingly, deposit account no. 23-2825 was charged the balance owed - \$30.00.

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<sup>1</sup> Note 37 CFR 1.121

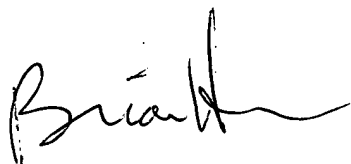
Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a stylized flourish at the end.

Charles Pearson  
Director, Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy